

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Bruce L. Kennedy
Application No. 10/662,599	Filing Date: September 15, 2003
Title of Application:	Video Recording and Image Capture Device
Confirmation No. 2356	Art Unit: 3739
Examiner	Philip R. Smith

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 CFR §41.41

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows.

Most of the arguments presented in the Examiner's Answer were presented during prosecution, and thus, have already been dealt with in Appellant's Appeal Brief. Appellant submits this Reply to briefly elaborate on issues raised in the Examiner's Answer.

The Examiner has submitted that “[i]t is not clear that the recited “stackable mating plug portions” require the elaborate rack mounted arrangement of screen and housing identified in the arguments” and that “Claim 21 does not recite a “rack”, nor does it refer to the arrangement of the touch screen relative to the housing.” (Examiner’s Answer, p. 10) The Examiner further went on to argue that “the touch screen disclosed by Winkler is “operatively coupled to computer circuitry disposed within housing 202” and that “[s]uch an arrangement conventionally requires “mating plug portions” which are always used to operatively connect various electronic elements.” (*Id.*) Finally, the Examiner submitted that the “modifier “stackable”, besides being broad, does not require that the mating plug portions be “stacked”, but only that they be “stackable”. It is maintained that mating plug portions are inherently “stackable” according to the meaning in plain English, and that the portions of the specification pointed to by the Applicant do not further animate the phrase.” (Examiner’s Answer, pp. 10-11)

Appellant respectfully submits that claim 21 recites “said housing and said touch screen include stackable mating plug portions.” The Examiner appears to be taking the position that because Winkler discloses a touch screen that is connected to circuitry, this inherently must comprise a “stackable” coupling arrangement as this word is “broad.” (*Id.*) Appellant disagrees.

Appellant agrees that the term “stackable” is broad, however, to extend this term to cover any type of coupling arrangement amounts to ignoring the language of the claims. *In re Geerdes*, 491 F.2d 1260, 1262, 180 U.S.P.Q. 789, the 791 (CCPA 1974) (All limitations of all claims must be considered, because it is improper to fail to consider any limitation in the claims.) If the Examiner’s interpretation of this claim term were proper, then the claim term would effectively read “said housing and said touch screen include mating plug portions”; as “stackable” is given absolutely no meaning beyond connectable, which is included in the phrase “mating plug portions” as used in claim 21.

Likewise, the Examiner's statement "that the portions of the specification pointed to by the Applicant do not further animate the phrase" lacks merit as the specification is the primary source for informing readers how claim terms should be interpreted. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). It is clear from the teachings of the specification as previously submitted that the term "stackable" has meaning and the term should not be stricken from the claim in forming a rejection over the cited prior art.

The Examiner further submitted that "[i]f the touch screen were not positioned within an interior cavity, as Applicant contends, it is difficult to comprehend how it would be "protect[ed] . . . during transportation and storage." (Examiner's Answer, p. 11) Appellant was very clear in submitting that folding the screen downward (face down) against an outer surface of the housing is not positioning the screen within the housing. The Examiner is effectively submitting that it is. Appellant disagrees as this again improperly ignores the term "within" used in claim 19. This would effectively render the claim term as follows: "said touch screen movable between a first position and a second position relative to the housing." Appellant respectfully submits that it is improper to ignore claim terms or interpret claim terms to have no meaning. *In re Geerdes*, 491 F.2d 1260, 1262, 180 U.S.P.Q. 789, the 791 (CCPA 1974).

The Examiner has still further submitted that the "touch screen in Winkler, which is "operatively connected" to the housing, is inherently "unpluggable", in that it is capable of being unplugged." (Examiner's Answer, p. 12) Appellant notes that the Examiner has provided absolutely no evidence to support this statement. From Appellant's reading of Winkler, it is not clear where this teaching can be supported. If one were to assume that any type of equipment can be disconnected from any other type of equipment because at one point they were connected, this would again improperly eliminate any meaning of the term "unpluggable."

Finally, the Examiner, in response to Appellants arguments stated that "Applicant contends that no evidence is provided for the assertion that the touch screen disclosed

by Beutter in view of Winkler can inherently be used by a plurality of medical instruments", the Examiner stated, "[i]t is maintained that the "endoscope 22" may be exchanged for, e.g., a placement "endoscope 22". Such a replacement "endoscope 22" need not be explicitly disclosed." (Examiner's Answer, p. 12) The Examiner further stated that the "touch screen disclosed by Beutter in view of Winkler may inherently be "used by a plurality of medical instruments" just as a light bulb may be used by a plurality of lamps." (*Id.*) Appellant disagrees with the Examiner's logic.

The Examiner is again improperly attempting to read claim terms out of the claims. The Examiner is effectively stating that the term "plurality of medical instruments" does not add anything to the claim as a single device may always be replaced there therefore comprises a plurality. Applicant respectfully disagrees. The Examiner has failed to point to any evidence that multiple devices could be used in cited combination as claimed, other than to simply assert that an identical second device could be used if the first device malfunctioned. It is incumbent upon the Examiner to establish the factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). It does not matter how strong the Examiner's convictions are that the claimed invention would have been obvious, or whether the Examiner might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103 as neither circumstance is a substitute for evidence lacking on the record.

Conclusion

For the foregoing reasons, Applicant respectfully submits that the claimed invention embodied in each of claims 19-31 and 46-49 is patentable over the cited prior art. As such, Applicant respectfully requests that the rejections of each of claims 19-31 and 46-49 be reversed and the Examiner be directed to issue a Notice of Allowance allowing each of claims 19-31 and 46-49.

Respectfully submitted,

October 20, 2008

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